

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAO-CHING CHEN and LESLIE E. BLACKFORD

Appeal No. 97-3708
Application 08/418,321¹

ON BRIEF

Before ABRAMS, STAAB and CRAWFORD, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 11-18, all the claims currently pending in the application. Two amendments have been filed subsequent to the

¹ Application for patent filed April 7, 1995.

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final rejection. The first amendment after final rejection (Paper No. 7, submitted November 20, 1996) has been refused entry (see the advisory letters mailed November 29, 1996 and January 13, 1997). The second amendment after final rejection (Paper No. 13, submitted February 24, 1997) has been entered (see the advisory letter mailed March 28, 1997).

Appellants' invention pertains to a method of forming a shoe cover. Independent claim 11, a copy of which is found in the appendix to appellants' brief, is illustrative of the appealed subject matter.

The references of record relied upon by the examiner in support of a rejection under 35 U.S.C. § 103 are:

Bodle	2,037,113	Apr. 14, 1936
Marx et al. (Marx)	2,617,208	Nov. 11, 1952
Stockum	4,047,251	Sept. 13, 1977

Claims 11-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Marx in view of Stockum and Bodle.²

² In the final rejection, claim 18 was also rejected under 35 U.S.C. § 112, second paragraph. Since (1) the advisory letter mailed March 28, 1997 indicated that the amendment after final submitted February 24, 1997 would be entered and that said amendment overcame the § 112, second paragraph, rejection, and since (2) no mention of this rejection has been made by the examiner in the answer, we presume that the examiner has withdrawn the final rejection of claim 18 on this

The

examiner has made the following finding:

Marx teaches a method of forming a shoe cover (overshoe) substantially as claimed except for the form (1) having first and second parallel lateral sides and recesses covering substantially all of the foot forming portion of the first and second sides. Stockum teaches a method of forming a glove comprising first and second parallel lateral sides and recesses covering substantially all of the hand forming portion of the first and second sides to facilitate dipping of a larger number of forms (column 2, lines 40-42) and to provide additional surface area (column 5, lines 6-15). Bodle teaches a method of forming a shoe cover comprising first and second parallel lateral sides, a generally flat form, to facilitate dipping of a larger number of forms (page 1, column 1, lines 28-34) and to provide a minimum of objectionable stretching to effect shaping (page 1, column 2, lines 10-14). [Answer, page 4.]

Based on the above, the examiner has made the following conclusions of obviousness:

It would have been obvious to provide the [Marx] method of forming a shoe cover as taught above with the form (1) having first and second parallel lateral sides and recesses covering substantially all of the foot forming portion of the first and second sides, in view of the teachings of Stockum

ground. *Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957).

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and Bodle, to facilitate dipping a large number of forms and to provide additional surface area on the forms. [Answer, page 4.]

In responding to appellants' arguments, the examiner has made the following additional comments:

In this case, the method of Marx and Stockum are very similar. The primary difference is that Marx is forming a [sic, an] overshoe and Stockum is forming a glove. Stockum teaches the advantage of using a relative[ly] flat form comprising first and second parallel lateral sides and recesses covering substantially all of the hand forming portion of the first and second sides to facilitate dipping of a large number of forms (column 2, lines 40-42) and to provide additional surface area (column 5, lines 6-15). The Bodle patent was applied above to further reinforce the idea that using a relatively flat form is an old and conventional step to facilitates [sic, facilitate] dipping of a large number of forms (page 1, column 1, lines 28-34). The Bodle reference is with regard to footwear, like Marx. The motivation to combine is to facilitate dipping of a large number of forms. [Answer, pages 6-7.]

At the outset, unlike the examiner, we do not see Marx as disclosing a method "substantially as claimed." The utilization of a form having first and second parallel lateral sides and recesses covering substantially all of the foot forming portion of the first and second sides, conceded by the examiner to be absent in Marx, is at the very heart of appellants' invention. In contrast to appellants, Marx

utilizes a "three-dimensional" form, i.e., a form that closely resembles the final shape of the overshoe.

Second, although Marx describes the overshoe thereof as being "lightweight" (column 7, line 57), it is clear from a consideration of the disclosure as a whole that the Marx overshoe is intended for extended wear in an outdoor environment. In this regard, note that Marx utilizes a multi-layer construction to

obtain a relatively thick reinforced sole portion, with the overshoe having a large groove and ridge corrugations on the sole for improved traction, and an overall sturdy construction to accommodate wearing "for a long time without the child's outgrowing it" (column 1, lines 41-42).³ While we appreciate that the appealed claims do not go into the particulars of the shoe cover produced by the claimed method, it is not at all clear to us that one of ordinary skill in the art would

³ In contrast, the shoe cover produced by appellants' method is described as being inexpensive, thin, lightweight, single use, and disposable (specification, pages 3-4).

consider the flat form of Stockum, which is used to produce thin and extremely pliable surgical or household gloves (column 1, lines 9-10 and line 40), to be a feasible way to make a reinforced overshoe like that of Marx.

Furthermore, one of ordinary skill in the art would regard the Bodle reference additionally relied upon by the examiner as adding little if anything to the proposed combination of Marx and Stockum. In Bodle the layer formed on the flat form 22, 23, upon

being stripped from the form and turned inside out,

is suitably trimmed at its ends, slit at the front, and is shaped upon a foot-shaped last 28 to provide a shoe upper. The various other shoe components, such as the insole and outsole and lining are assembled with it upon the last in any desired manner and the whole then vulcanized upon the last whereupon all parts will have the desired final shape. [Page 2, left column, lines 8-16.]

Thus, in Bodle the layer formed on the flat form 22, 23 is but one component of the finished vulcanized shoe. For this reason, Bodle is simply inapposite the teachings of Marx and

Stockum, where dipping alone produces the finished product.

It is error to consider the references in less than their entirety, i.e., to disregard disclosures in the references that diverge from and teach away from the invention at hand. *W. L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983). Here, we do not believe the perceived production advantage (e.g., to facilitate dipping a larger number of forms) proposed by the examiner as the motivation for using Stockum's flat forms in Marx would have led the ordinarily skilled artisan to disregard the differences in finished products of Stockum and Marx and assume that Stockum's

flat forms for producing thin and extremely pliable gloves would be applicable to the method of Marx, where the finished product is a multi-layer, reinforced overshoe.

In light of the above, we find ourselves in agreement with appellants' position as set forth on pages 5-6 of the brief that one of ordinary skill in the art would not have

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found it obvious to use a flat form of the type disclosed by Stockum in the method for forming the sturdy three dimensional boot of Marx, absent the hindsight accorded one who first viewed appellants' disclosure. Such hindsight reconstruction, of course, is not a proper basis for establishing the obviousness of the subject matter of claims. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). We therefore will not sustain the standing § 103 rejection of the appealed claims as being unpatentable over Marx, Stockum and Bodle.

Under the provisions of 37 CFR § 1.196(b), we enter the following new rejection.

Claim 18 is rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter sought to be patented. This claim is

directed to a method of forming a shoe cover, and recites a number of steps (providing a form, dipping the form into

various solutions, drying the layers deposited on the form, etc.) consistent with that method. In addition, claim 18 sets forth in the last paragraph thereof the step of "donning said shoe cover over a foot during a medical procedure." Clearly, this step is not consistent with a method of forming a shoe cover, but rather relates to a method of using a shoe cover. It is not clear whether claim 18 is directed to a method of forming a shoe cover (as called for in the preamble of the claim and as consistent with the majority of the steps appearing in the body of the claim), a method of using a shoe cover (as the "donning" step would appear to indicate), or a mixed method of both forming and using a shoe cover (as one might presume from reading the method steps appearing in the body of the claim without regard for the preamble).

Further, even if we were to consider claim 18 to be drawn to a mixed method of forming and using a shoe cover, as appellants would apparently have us do, we would have serious reservations about the claim. The purpose of the requirement stated in the second paragraph of 35 U.S.C. § 112 is to provide those who would

endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). If claim 18 is considered to be drawn to a mixed method of forming and using, it is unclear whether the potential infringer would be the maker of the shoe cover, the user of the shoe cover, both the maker and the user, or only one who makes and then uses the shoe cover.

For these reasons, it is our view that claim 18 does not pass muster under the second paragraph of 35 U.S.C. § 112.⁴ Appellants' argument on page 8 of the brief in response to the examiner's withdrawn § 112, second paragraph, rejection has been considered. For the reasons discussed above, we simply do not agree with appellants that the claim "clearly shows that [it] is a method of forming and protecting." Further, we

⁴ We appreciate that this rejection is essentially the same rejection that was apparently withdrawn by the examiner in light of appellants' second amendment after final rejection, submitted February 24, 1997.

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do not agree with appellants that "[o]ne reading the claim would not be confused as to its scope merely by the inclusion of the donning step." Rather, the inconsistency between the preamble of the claim and the body of the claim leads to uncertainty as to the scope of the claim.

In summary, the standing 35 U.S.C. § 103 rejection of the appealed claims is reversed, and a new rejection pursuant to 37 CFR § 1.196(b) has been entered.

The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings

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(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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LAWRENCE J. STAAB)	BOARD OF PATENT
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